

In re Application of: Christoph KIRSCH, et al.

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REMARKS

Claims 2, 3, 8, 9, 22, 39 and 42-45, are pending in this application. Claims 1, 4-7, 10-21, 22-38, 40 and 46 have been withdrawn as being directed to non-elected subject matter. The elected claims set forth, herein, are merely to comply with the Restriction Requirement and is not to be construed as surrender of any subject matter in the instant application. Applicants hereby reserve the right to pursue the subject matter of the canceled or withdrawn claims in one or more divisional patent applications.

Claims 2 and 22 have been amended to include the term "consisting of." No new matter has been added by virtue of these amendments and their entry is respectfully requested.

Applicants are filing herewith a Request for Continued Examination (RCE) due to the finality of the Office Action, and the appropriate fee.

Claim Objections

Claim 42 is objected to because of the following informalities: "a word is missing between the word "claim" and the word "wherein". Appropriate correction is required." In response, Applicants have amended the claim to indicate that claim 42 is dependent on claim 2. Applicants respectfully request reconsideration and withdrawal of the objection.

Claim Rejections Under 35 U.S.C. § 112

Claims 2, 3, 8, 9, 39 and 42-45 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner asserts that claim 2 is "vague and indefinite in that the metes and bounds of "two or more cis-acting elements are unclear." Applicants have amended the claim to clearly indicate that the chimeric promoter capable of mediating local gene

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expression in plants upon pathogen infection comprises two or more *cis*-acting elements sufficient to direct elicitor-specific expression of a nucleic acid sequence, wherein a *cis*-acting elicitor responsive element comprises a nucleotide sequence of SEQ ID NO: 11, and a minimal promoter. Support for this amendment is found throughout the specification. For example, the term "*cis*-acting element" is defined on page 3, lines 29-30, through to page 4, lines 1-5; the eleven *cis* acting elicitor-responsive elements (SEQ ID NO's: 3-13) are described on page 4, lines 23-31 through to page 5, lines 1-2; Example 2, page 30, describes SEQ ID NO: 11. No new matter is added by virtue of this amendment and its entry is respectfully requested.

Claim 42 is objected to, because it "recites the limitation "said at least one *cis*-acting element" in claim 2. In response, Applicants have amended claim 42 to correct the antecedent basis. No new matter is added by virtue of this amendment and its entry is respectfully requested.

Claim Rejections Under 35 U.S.C. § 102

Claim 2, 22 and 39 are rejected under 35 U.S.C. § 102(b) as being anticipated by van de Locht *et al* (*EMBO J*, 1990, vol 9(9) p 2945-2950; see entire document).

Applicants respectfully traverse.

Locht *et al.*, does not teach or disclose a chimeric promoter comprising SEQ ID NO: 11 and a minimal promoter. Figure 5, does not teach or disclose that SEQ ID NO: 11 is an elicitor responsive element. Furthermore, Loch et al., fail to teach a chimeric promoter capable of mediating local gene expression in plants upon pathogen infection comprising two or more *cis*-acting elements sufficient to direct elicitor-specific expression of a nucleic acid sequence, wherein a *cis*-acting elicitor responsive element comprises a nucleotide sequence of SEQ ID NO: 11, and a minimal promoter.

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As such, Locht et al., fails to teach each and every limitation of claims 2, 22 and 39.

In view thereof, Applicants respectfully request reconsideration and withdrawal of the instant rejection.

Claim Rejections Under 35 U.S.C. § 103.

Claim 2 is rejected under 35 U.S.C. § 103(a) as being unpatentable over van de Locht *et al.*, (EMBO J., 1990, vol 9(9) p. 2945-2950) in view of Pears and Williams (*Nucleic Acids Research*, 1988, Vol 16(17), pages 8467-84861) and Searle *et al.*, *MCB*, 1985, Vol 5(6), pages 1480-1489) further in view of Comai *et al.*, (*Plant Molecular Biology*, 1990, Vol 15(3), pages 373-381).

Applicants respectfully traverse.

As discussed above, van der Locht et al., do not teach or disclose the elicitor element identified by SEQ ID NO: 11. It would not be obvious to one of ordinary skill in the art to identify the actual fragment that is the elicitor-specific responsive element. Furthermore, Locht *et al.*, do not teach "two or more *cis*-acting elements" that make up the chimeric promoter. The Examiner rejects the claim on the "alternative reading of the claim that the promoter comprises at least two copies of SEQ ID NO: 11." In response, Applicants have amended the claim to recite "consisting of."

Pears and Williams discuss that "these sequences are either essential promoter elements, not themselves interaction with the inducer, or that their interaction with a separate class of control sequences is necessary for inducible expression. (See, Abstract; emphasis added). These cysteine proteinase elements do not function as elicitor-specific responsive elements, may not be used to confer cAMP inducibility on a heterologous gene and thus cannot be compared to the instant invention. (Abstract;

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penultimate line). These cysteine proteinase elements are also different sequences in relation to each other, i.e. CP1 and CP2, and encode coordinately expressed mRNA sequences. Applicants teach use of the same sequence as an elicitor responsive element. Further, for the reasons discussed above, Locht *et al.*, do not teach or disclose the instant invention and as such the combination of these references fail to rise to the level of obviousness.

Searle *et al* and Cornai *et al.*, fail to make up for the deficiencies of van der Locht *et al*. Neither of these references teaches a chimeric promoter consisting of SEQ ID NO: 11 and to . Furthermore, Searle *et al.*, discusses that a single element did not respond to zinc as opposed to "increasing the inducibility." Neither Sear *et al* and Cornai *et al.*, teach or disclose use of the same sequence as an elicitor responsive element, that is SEQ ID NO: 11. Taken alone or in combinations, none of these references teach or disclose the instant invention.

In view thereof, Applicants respectfully request reconsideration and withdrawal of the instant rejection.

CONCLUSION

Applicants respectfully request entry of the foregoing amendments and remarks and reconsideration and withdrawal of all rejections. It is respectfully submitted that this application with claims 2, 3, 8, 9, 22, 39 and 42-45 is in condition for allowance.

This response is being filed with a petition for a three month retroactive of time and the required fee. Although, Applicants believe that no further extensions of time are required with submission of this paper, Applicants request that this submission also be considered as a petition for any further extensions of time if necessary. The Commissioner for Patents and Trademarks is hereby authorized to charge the amount due for any retroactive extensions of time and any deficiency in any fees due with the filing

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of this paper or credit any overpayment in any fees paid on the filing or during
prosecution of this application to Deposit Account No. 50-0951.

Respectfully submitted,
AKERMANTENTERFITT



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